## REMARKS

Reconsideration of this application is respectfully requested.

This application has been reviewed in light of the Office Action dated March 9, 2007. Claims 1-5, 8-14 and 17-19 are currently pending in the application. No claim has been amended and therefore no new issues have been raised that would require further searching.

Claims 1, 8, 14 and 19 were rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. The Examiner asserted "Claims 1, 8, 14 and 19, contain the newly amended limitations requiring the selecting and/or displaying of displayed heading or at least one official class, entered freely chosen wording, proposed wordings, and displayed number of at least one official class in a trademark registration application. The specification does not describe the situation wherein these items were displayed or selected "in" the trademark application".

Applicants respectfully disagree with the Examiner's assertion regarding the 35 USC 112, first paragraph, rejection. As indicated by the title of the present application, the subject matter of the present application is directed to a "PROCESS FOR PREPARING A TRADEMARK APPLICATION". As pointed out in the Abstract of the present application, the "process for *preparing a trademark application*" is accomplished "by means of a local computer...including the following steps, performed on the local computer: (i)entering the trademark, (ii) selecting..., (iii) validating..., (iv) sending..., said steps being carried out in the order indicated". It would be readily apparent to one skilled in the art that these steps would be carried out in the trademark application as the steps are carried out to "prepare a trademark application". No where in the present application it is suggested any of the steps

would be preformed elsewhere. These steps for preparing a trademark application are repeated several times through the present application including at least at paragraphs [0030]-[0035]. Paragraphs [0030]-[0036] recite:

> The present invention has precisely this dual objective, and relates to a process as defined in the first paragraph of the present description, which is characterised in that it includes the following steps, carried out on a local computer: (i) entering the trademark, (ii) selecting the products or services to which the trademark applies, (iii) validating the entry and the selection, (iv) sending the validated entry and selection to the remote computer via the computer network, said steps being carried out in the order indicated. *It is thus easier to prepare a trademark application,* and the case is swiftly transmitted to the remote computer with a view to action being taken. (Emphasis added).

From the above passages, it is clear the steps taken (for example "(i) entering the trademark to be filed at the national administrative department in a trademark registration application displayed on the local computer" and "(ii) selecting from the displayed trademark registration application at least one displayed heading of at least one official class of products or services" as recited in claim 1) are performed in the trademark application thus making it easier to prepare a trademark application.

Furthermore, original claim 1 recites "*Process for preparing a trademark registration application*, by means of a local computer...*characterized in that it includes the following steps*, performed on the local computer: (i) entering the trademark, (ii) selecting the

products or services to which the trademark applies, (iii) validating the entry and the selection, (iv) sending the validated entry and selection to the remote computer via the computer network, said steps being carried out in the order indicated" (Emphasis added). The preamble of original claim 1 specifically sets forth that the claim is directed to a "process for preparing a trademark registration application" which sets the context for the claim. ("[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).) Original claim 1 goes on further to recite "entering the trademark"; where else would the trademark be entered but the trademark registration application as set forth in the preamble of the claim. The same holds true for the selecting step, as it is known by one skilled in the art of preparing a trademark application that the products and services to which the trademark applies are selected and entered in the trademark registration application with the entered trademark. Therefore, it is respectfully submitted that claim 1 in its present form is enabled to one skilled in the art to which it pertains and the rejection under 35 USC 112, first paragraph, should be withdrawn.

Similarly, the limitations of claims 8, 14 and 19, in their current state, are supported by at least by paragraphs [0051]-[0056], [0065] and original claims 8-13 which depended from original claim 1.

Claims 1-5, 8-14 and 17-19 were rejected under 35 USC 103(a) as being

unpatentable over Lee (US 7,016,851) in view of the USPTO's "Trademark/Service Mark Application, Principal Register, with Declaration", 08/22/00, pp.11 (hereinafter "TEAS") in further view of "Frequently Asked Questions About Trademarks:, 02/11/00, pp. 1-42 (hereafter "FAQ") in further view of Petruzzi et al (US 6,049,811) as set forth on pages 3-17 of the Office Action dated March 9, 2007.

In regards to Claim 1, as set forth in the previous Office Action, the Examiner asserted "Lee teaches a process for registering a trademark by means of a local computer (Fig. 2:221) connected to a remote computer (Fig. 2:231, 234, 241, 253, etc) via a computer Internet network (column 7, lines 40-41 and 61-62) performing the following steps in order: entering the trademark ...; sending the validated entry and selection...; and retransmitted the validated entry and selection..". The Examiner goes on to state: "Lee does not specifically teach ...selecting from the displayed trademark application at least one displayed heading of at least one official class of products or services to which the trademark applies ...". The Examiner then asserted "TEAS teaches ...selecting the products or services (i.e. user could enter known Goods and/or services) to which the trademark applies from at least one of an official class (Page 4: "International Class" and "Listing of Goods and/or Services") and validating the entry and selection (Page 8: "Validate Form"). TEAS also teaches wherein the corresponding number of the at least one official class could be displayed in the trademark registration application (Page 4: i.e. user could enter known corresponding class in the "international Class" entry box in the application"). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2:221) transmitting the trademark filing documents (Column 10, lines 59-65) to have utilized the TEAS system, because Lee

teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23)". Furthermore, the Examiner asserted: "[n]either Lee nor TEAS specifically teaches selecting one displayed heading of official class of products. FAQ teaches that a user utilizing the TEAS system could select the "Listing of Goods and/or Services" link (page 4) and retrieve the FAQ page from which a user could select one of a displayed heading of an official class of products".

In the latest Office Action, the Examiner now adds Petruzzi et al for "teach[ing] a method for creating an intellectual property application (e.g., patent, copyright, trademark, service marks)(column 5, lines 12-16) wherein the act of selecting and displaying was done within the intellectual property application (Fig. 4:290)". The Examiner asserted " [I[t would have been obvious to one of ordinary skill in the art at the time of the invention for the user of TEAS to have been able to select the displayed heading from within the application, because Petruzzi et al taught that selecting and displaying the available content of the intellectual property application in the application drafting area (Fig. 4:290) provided an improved computer based aid in drafting an application...".

Petuzzi et al is directed to a machine and method for drafting a patent application. The only type of intellectual property application disclosed or suggest is a patent application. Column 5, lines 1-16 states:

> Upon selecting Starting 31 by a variety of means, such as positioning a cursor over the button and clicking with a mouse button or selecting and depressing the Enter key on the keyboard, information such as Introduction to PatentPro™,

> Frequently Asked Questions, and Other Forms of Protection may be accessed through, for example a well known help system. Introduction to PatentPro™ may provide helpful information to an inventor regarding the use of PatentPro™, ***while Frequently Asked Questions may provide the questions and answers to general information concerning intellectual property***, and patents in particular. ***Other Forms of Protection may provide information regarding intellectual property such as trademarks, service marks,*** copyrights, trade dress, and trade secrets, design patents, plant patents, provisional patent applications, and the U.S. Patent Office's document disclosure program, to name a few.

The machine and method of Petruzzi et al. only discloses information on other types of intellectual property. No where in Petruuzi et al. is it suggested that the machine or method can be used for other types of intellectual property applications. Therefore, it is respectfully submitted Petruzzi et al. does not cure the deficiencies of Lee, TEAS and FAQ.

Claim 1 of the instant application is directed to a process "for preparing a trademark registration application to filed at a national administrative department responsible for examining the application" including the steps of, inter alia, "(i) entering the trademark to be filed at the national administrative department in a trademark registration application displayed on the local computer, (ii) selecting from the displayed trademark registration application at least one displayed heading of at least one official class of products or services to which the trademark applies and displaying a corresponding number of the

selected at least one official class in the trademark registration application, (iii) validating the entry and the selection, (iv) sending the validated entry and selection to the remote computer via the computer network, the remote computer being disposed on a premises of an intellectual property attorney for reviewing the trademark registration application, (v) retransmitting the validated entry and selection from the premises of the intellectual property attorney to another remote computer to enable the application to be prosecuted at the national administrative department, said steps being carried out in the order indicated" (emphasis added). The process of Claim 1 facilitates the preparation of a trademark application by allowing an applicant to select products or services from known official classes of products and services right in the application. By "selecting from the displayed trademark registration application at least one displayed heading of at least one official class", the process of Claim 1 will enable the applicant to select products or services that should be accepted by the national administrative departments, e.g., corresponding trademark offices, responsible for examining the trademark applications with a view to nationally or internationally registering the trademark in the application. The process of Claim 1 will then "display[ing] a corresponding number of the selected at least one official class in the trademark registration application" thus completing two of the more difficult entries of the trademark registration application (see instant application paragraph [0008]). The applicant of the trademark application will then send the validated entry of the trademark and selection of goods and services and corresponding official class number to a remote computer of an intellectual property attorney for review, who will then transmit the application to the national administrative department. By having the applicant select from the trademark registration application at least one heading of an official class and causing

the corresponding class number to be displayed in the trademark registration application, the process of Claim 1 will eliminate the need for the applicant to jump around to several different sources of information, e.g., different portions of a web site, to collect the necessary information to complete a trademark application.

Neither the Lee nor TEAS nor FAQ nor Petruzzi et al. disclose "selecting from the displayed trademark registration application at least one displayed heading of at least one official class of products or services to which the trademark applies and displaying a corresponding number of the selected at least one official class in the trademark registration application" as recited in Claim 1. Lee does not provide any detail on how to file a trademark registration application. The Examiner asserted "TEAS teaches selecting the products or services (i.e. user could enter known Goods and/or services) ... TEAS also teaches wherein the corresponding number of the at least one official class could be displayed in the trademark registration application (Page 4: i.e. user could enter known corresponding class in the "international Class" entry box in the application)" and FAQ merely teaches the official heading and numbers for different classes of goods and/or services. Petruzzi et al. only discloses preparing a patent application. There is no suggestion or teaching in any combination of the references that allows the selecting of a heading of an official class from the trademark application and subsequently displaying the corresponding class number in the trademark application. The combination of cited references teaches manually entry of information into the trademark application from sources outside of the displayed trademark registration application.

Therefore, it is respectfully submitted that Claim 1, along with dependent claims 2-5, 8-13 and 17, is patentably distinct and not rendered obvious over Lee in view of the TEAS

reference in further view of the FAQ reference in further view of Petruzzi et al.

Similarly, Claim 19 is directed to a process "for preparing a trademark registration application to filed at a national administrative department responsible for examining the application" including the steps of, inter alia, "(ii) selecting from the displayed trademark registration application at least one displayed number of at least one official class of products or services to which the trademark applies and displaying a corresponding heading of the selected at least one official class in the trademark registration application" (emphasis added). On page 4 of the TEAS reference, a user can enter an International Class number, not select from the trademark application a displayed number of at least one official class, but that entry will not result in the heading of the official class being displayed in the trademark registration application. There is no where on page 4 that allows the selecting from the application of a number of at least one official class and subsequently displaying the corresponding heading of the official class in the trademark registration application. Furthermore, page 10-11 of the TEAS reference shows a result set after entering a proposed good or service in the Trademark Acceptable Identification of Goods and Services Manual not the subject trademark application. The result set includes acceptable goods along with the corresponding International Class number. Neither the class number nor suggested goods are selectable which would enter them into the trademark registration application. Therefore, it is respectfully submitted that Claim 19 is patentably distinct and not rendered obvious over Lee in view of the TEAS reference in further view of the FAQ reference in further view of Petruzzi et al.

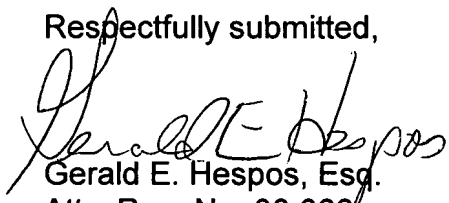
Claim 14 is directed to a process "for preparing a trademark registration application to filed at a national administrative department responsible for examining the application"

including the steps of, inter alia, "(ii) entering in the application at least one freely chosen wording for describing the products or services to which the trademark applies, (iii) comparing said freely chosen wording with potential wordings contained in a file of at least one official class of products and services, (iv) displaying in the application proposed wordings from among the potential wordings, (v) selecting from the displayed application at least one wording from among the displayed proposed wordings and entering the selected wordings in the trademark registration application, (vi) displaying in the trademark registration application a number of the official class corresponding to the wordings selected, (vii) validating the entry and the selection"(emphasis added). The process of Claim 14 facilities preparation of a trademark registration application by providing the applicant with proposed wordings for goods and services associated to the trademark. The process further facilitates preparing the trademark registration application by displaying wordings to a user in the application and then entering the wordings in the application selected by the applicant via the local computer, i.e., the entry and selection steps are all completed while the applicant is in the application. Page 10 and 11 of the TEAS reference illustrates a separate web page of the USPTO's website and is not part of the trademark application form shown on page 4 of the TEAS reference. In practice, a user would go to the Trademark Acceptable Identification of Goods and Service Manual web page, shown in the reference at page 10, and enter a good or service. A listing of acceptable goods or services would result as shown on page 11 of the TEAS reference. The user would then choose an acceptable good or service from the list and then either write it down, memorize it or cut and paste the choice into the trademark application form shown on page 4 of the TEAS reference, that is, the user can not select a choice from the application and have it

automatically transferred to the application. Neither Lee nor the TEAS reference disclose or suggest "entering in the application at least one freely chosen wording" and "selecting from the displayed application at least one wording from among the displayed proposed wordings and entering the selected wordings in the trademark registration application" as recited by Claim 14. However, the Examiner asserted Petruzzi et al teaches the selecting. As described above in relation to claim 1, Petruzzi et al. does not discloses or suggest preparing a trademark registration application. Therefore, it is respectfully submitted that Claim 14, along with dependent claim 17, is patentably distinct and not rendered obvious over Lee in view of the TEAS reference in further view of Petruzzi et al.

In view of the preceding amendments and remarks, it is respectfully submitted that all pending claims, namely claims 1-5, 8-14 and 17-19 are in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicants' attorney at the number given below.

Respectfully submitted,



Gerald E. Hespos, Esq.
Atty. Reg. No. 30,066
Customer No. 001218
CASELLA & HESPOS, LLP
274 Madison Avenue - Suite 1703
New York, New York 10016
Tel: (212) 725-2450
Fax: (212) 725-2452

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